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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,011	01/22/2002	Guerin Dubose Rife	RIF-114	7788

21884 7590 07/17/2003

WELSH & FLAXMAN LLC  
2341 JEFFERSON DAVIS HIGHWAY  
SUITE 112  
ARLINGTON, VA 22202

EXAMINER

DUONG, THANH P

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 07/17/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

N,K

**Office Action Summary**

Application No. 10/051,011		Applicant(s) RIFE, GUERIN DUBOSE	
Examiner Tom P Duong		Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 68 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 68, the limitation " a bottom edge of said upper portion is defined by a ledge coincident with a top edge..." is indefinite and inaccurate. Herein, a ledge is best understood to be the cavity upper side wall 130 coincident with the interface 123. (See Applicant's disclosure page 9, lines 20-22).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 61-66, 68 and 71-72 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Teramoto et al. (4,645,207). Teramoto et al. discloses a set golf club irons (Figures 1- 2) including a hosel portion to receive a shaft (Figure 2), heel, toe, striking surface, top ridge surface, and bottom sole surface, wherein a rear surface having upper portion with a ledge and

Art Unit: 3711

lower portion extending entirely across from heel to toe; said upper portion extending downwardly toward bottom sole approximately midway between top ridge and bottom sole; lower portion extending upwardly toward top ridge approximately midway between bottom sole and top ridge; said lower portion including an elongated cavity solely in the lower portion of the rear surface; and ball striking face that is thinner than the thickness between the non-cavity portions and the ball striking face (Figures 4a, 4b, 4c). Note, Teramoto discloses that the volume of hollow portion or cavity gradually decreases from long iron to short iron and the sole width gradually increased from the short iron to the long iron (Col. 2, lines 18-35). Thus, it is inherent and obvious that a long iron has an upper portion extending downwardly less distance than a shorter iron due its larger cavity. Likewise, a shorter iron has a smaller volume of cavity in the lower portion which inherently provides an upper portion extending downwardly with greater distance toward the lower portion.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 67 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teramoto '207 in view of Gorman '835 and Antonious '924. Regarding claims 67 and 70, Teramoto '207 does not show a mass in the lower portion of the rear surface.

Art Unit: 3711

Gorman '835 teaches a periphery mass 22 formed on the lower portion of the rear surface (Abstract) to improve weight distribution in the club head which improves accuracy and flight distance (Col. 1, lines 16- 21). Antonious '924 also teaches weights are formed on the rear club face extending from heel to toe portion to improve weight distribution at the bottom portion of the club head (Col. 1, lines 5-68). Thus, it would have been obvious in view of Gorman and Antonious to fabricate the club head of Teramoto to include weights or mass in the lower portion of the rear surface as taught by Gorman and Antonious in order to further improving weight distribution in the lower portion of the rear surface. Regarding claim 69, Official Notice is taken that it is known in the art to provide insert with various specific gravity in the elongated cavity and it would have been obvious to do so here to improve moment of inertia and mass distribution.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

Art Unit: 3711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 873-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Tom Duong  
July 8, 2003



Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700